



UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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APR 10 2002

Paper No. 9

In re Application of
John R. Fredlund *et al*
Application No. 09/213,169
Filed: December 17, 1998
Attorney Docket No. 78685F-P

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: DECISION ON PETITION
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The papers submitted by facsimile transmission on April 4, 2002 are construed as constituting a petition under 37 CFR 1.181 for withdrawal of the examiner's holding that this application stands abandoned. No fee is required.

The petition is dismissed as being untimely.

Technically, this application stands abandoned due to the dismissal of petitioners' appeal for failure to file an appeal brief, 37 CFR 1.192, in an application which contains no allowed claims. A Notice of Abandonment was mailed to petitioners on June 5, 2001. The papers submitted on April 4, 2002 were, therefore, filed eleven (11) months after petitioners were notified of the status of the application. Pursuant to 37 CFR 1.181(f) and MPEP § 711.03(c), a petition to withdraw a holding of abandonment filed more than two (2) months subsequent to notification that the application stands abandoned will be dismissed as untimely absent an appropriate terminal disclaimer.

Petitioners are advised that an appropriate terminal disclaimer in this application is not a terminal disclaimer containing the language used with respect to overcoming an obviousness type double patenting rejection. As set forth in MPEP § 711.03(c):

"The Office may treat an untimely petition to withdraw the holding of abandonment on its merits in a utility or plant application filed on or after June 8, 1995, on the condition that the petition is accompanied by a terminal disclaimer dedicating to the public a terminal part of the term of any patent granted thereon that would extend beyond the date 20 years from the filing date of the application, or the earliest application to which the application specifically refers under 35 USC §§ 120, 121, or 365(c). ... the terminal disclaimer must also apply to any patent granted on any application that claims the benefit of the filing date of the application under 35 USC §§ 120, 121, or 365(c). Such a terminal disclaimer is not required under 37 CFR 1.137(c) because abandonment of an application is a per se failure to exercise due diligence, and as such, an applicant cannot obtain patent term extension under 35 USC § 154(b) due to prosecution delay caused by abandonment of the application. Where a petition to withdraw the holding of abandonment is granted, the application is considered to never have been abandoned and, as such, the prosecution delay caused by the treatment of the application as abandoned is not considered a per se failure to exercise due diligence. Thus a terminal disclaimer is required to avoid granting patent term extension under 35 USC § 154(b) due to prosecution delay caused by the treatment of the application as abandoned."


Petitioners may file a renewed petition to withdraw the holding of abandonment, without a fee.

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The renewed petition may consist of an appropriate terminal disclaimer and a request that the papers submitted on April 4, 2002 be reconsidered in light of the terminal disclaimer as a timely petition to withdraw the holding of abandonment. The renewed petition must itself be filed within two months of the date of this Decision. 37 CFR 1.181(f).

The application is being retained in Technology Center 3700 awaiting the filing of a renewed petition, or other action deemed appropriate by petitioners.

PETITION DISMISSED.


E. Rollins-Cross, Director, Patent
Examining Groups 3710 and 3720

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